

--10--

REMARKS

Claims 1-8, 10, 32-41, and 52-63 are currently pending in the application. By this amendment, claim 1 is amended for the Examiner's consideration. The above amendment is made for clarification only to overcome the formality presented in the rejection under 35 U.S.C. §112, 2nd paragraph. Applicant submits that the amendment to claim 1 now clearly recites that one or both the steps (numbered (i) and (ii)) can be performed in the method of the presently claimed invention. Applicant submits that this amendment should be entered as it places the application in better form for appeal, by reducing issues, and is being filed prior to a Notice of Appeal. Applicant further submits that the present invention does not add any new issues that require further search and/or consideration and, as such, entry of the amendment is proper in accordance with MPEP 714.12 which states, in part:

...

(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

...

--11--

Any amendment that will place the application either in condition for allowance or in better form for appeal may be entered. Also, amendments >filed after a final rejection, but before or on the date of filing an appeal,< complying with objections or requirements as to form are to be permitted after final action in accordance with **37 CFR 1.116(b)**.

35 U.S.C. §103 Rejections

Applicant incorporates the remarks set forth in the amendment filed on December 9, 2009. In this office action, the Examiner asserts:

Applicant's arguments filed on December 9, 2009 have been fully considered but they are not persuasive. Applicant argues that the cited references are not directed to managing and tracking changes in an organization. (See Response, pages 10 and 13). Examiner respectfully disagrees. Buchanan discloses that a key part of business modeling is to identify "change drivers" and "concentrate on those aspects of the business process that will need to be changed in order to deliver the new corporate values and priorities." (Page 6: final paragraph). The models also help in an "analysis of the gap between what already exists and what is called for by the changed strategy." (Page 7). Buchanan also discloses gap analysis and migration planning (see figure 4 and 5). Thus, Buchanan is directed to managing and tracking changes in an organization.

Applicant notes that the arguments were not directed to the "cited references are not directed to managing and tracking changes in an organization". This is taking Applicant's argument completely out of context. Applicant argued, which is maintained herein, at page 10:

--12--

In response to Applicant's representative's proposal to clarify the claims to more clearly define the goals, values, capabilities, and resources and/or to further clarify that the invention relates to managing and tracking changes in an organization by presenting or displaying the changes from "as-is" to "to-be", the Examiner agreed that adding such language to the claims would advance prosecution and that the prior art rejections might be overcome.

Applicant further argued on pages 12 and 13:

... While BUCHANAN teaches a system for aligning IT projects with corporate goals and priorities (see page 1, 3rd paragraph), BUCHANAN is silent regarding the capturing and displaying of current resources of the organization and how they relate to the organizations' mission in real-time and directly tracking which specific resources directly support the capabilities, as well as illustrating and quantifying a value of transforming an enterprise business model of the organization from a current "as-is" state to a proposed "to-be" business model. BUCHANAN is also silent regarding the goal being defined as a corporate directive establishing a final end point of an enterprise change, the value being defined as a customer value, the at least one capability being a strategic capability that represents critical functions that the organization must be capable of doing to insure delivery of the customer value, and the resource being defined as a physical component that must be present and supports the at least one capability. Again, this language defines the invention to the context of managing and tracking changes in an organization as opposed to merely aligning IT projects with corporate goals and priorities.

In any event, Applicant is filing herein a Notice of Appeal to have the arguments considered by the Board of Patent Interferences and Appeals. Applicant requests reconsider and withdraw the rejection of the above-noted claims under 35 U.S.C. § 103(a).

--13--

CONCLUSION

In view of the foregoing amendments and remarks, Applicant submits that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicant hereby makes a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 09-0457.

Respectfully submitted,
Marybeth AHERN, et al.



Andrew M. Calderon
Registration No. 38,093

Roberts, Mlotkowksi, Safran & Cole PC
P.O. Box 10064
McLean, VA 22102
Phone: 703.677.3011
Fax: 703.848.2981
Email: a-calderon@rmsclaw.com